

REMARKS

Claims 1, and 4-6 are pending in this application. By this Amendment, claims 1 and 4-6 are amended, and claims 2 and 3 are canceled without prejudice to or disclaimer of the subject matter therein. Support for the amendments to claims 1 and 4-6 can be found in the specification as originally filed, for example, at page 13, Tables 1 and 2 (Silica 4), and in claims 1 and 4-6 as originally filed. No new matter is added by these amendments.

The courtesies extended to Applicants' representative by Examiner Chang at the interview held July 21, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

I. Specification

The Office Action requests that the specification be updated to include a cross-reference to related applications. By this Amendment, the first paragraph of the specification is amended to set forth the patent number and issue date of the application of which the instant application is a divisional. No new matter is added.

II. Claim Rejections Under 35 U.S.C. §112

The Office Action rejects claims 3 and 5 under 35 U.S.C. §112, first paragraph, as based on a disclosure that is not enabling. The Office Action also rejects claims 1-6 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. While Applicants do not necessarily agree with these rejections, claims 1 and 5 are amended herein to more clearly set forth subject matter that is both enabled and not indefinite; claims 2 and 3 are canceled herein.

In particular, claim 1 is amended to incorporate the subject matter of claim 2, which further defines the relationship between D_1 , h_1 and h_2 and, as discussed in the July 21

interview, the relationship between D₁ and D₂. As agreed during the July 21 personal interview, this amendment to claim 1 overcomes the rejections under §112, first and second paragraph.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

III. Double Patenting

The Office Action rejects claims 1, 2 and 4 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 5 of U.S. Patent No. 6,514,433 to Takeichi et al.; over claims 1, 2 and 4 of U.S. Patent No. 6,566,422 to Yagi et al.; over claims 1, 4, 5 and 8 of U.S. Patent No. 6,451,875 to Suga et al.; over claims 1, 2, 6 and 7 of U.S. Patent No. 6,673,858 to Takeichi et al.; and over claims 1 and 2 of U.S. Patent No. 6,426,021 to Suga et al.

However, the instant application and the cited references were, at the time of the invention disclosed and claimed in the instant application, owned by Sony Chemicals Corp. Although Applicants do not necessarily agree with these rejections, in response to the provisional obviousness-type double patenting rejections, Applicants attach hereto a Terminal Disclaimer. Applicants submit that, in light of the Terminal Disclaimer, the rejections are moot. Applicants respectfully request withdrawal of these rejections.

IV. Claim Rejections Under 35 U.S.C. §102/§103

The Office Action rejects claims 1-6 under 35 U.S.C. §102(e) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent No. 6,083,774 to Shiobara et al. Applicants respectfully traverse this rejection.

Independent claim 1 sets forth, in pertinent part, an "adhesive material ... containing at least one curable resin and inorganic particles, wherein as to the inorganic particles, their

specific surface area S (m^2/g) satisfies Equation (1) ... $11 < S \leq 17$ (1)." Claims 4-6 depend from claim 1 and incorporate all of the limitations thereof.

Shiobara discloses encapsulating resin compositions for use in fabricating semiconductor devices. *See* Shiobara, col. 1, lines 4-5; col. 1, lines 29-37. The Shiobara composition includes an epoxy resin, a curing agent and an inorganic filler having a maximum particle size of $24 \mu\text{m}$. *See* Shiobara, col. 1, lines 61-65. Shiobara discloses that its inorganic filler, which may be fused silica or alumina, has a specific surface area, measured by the BET absorption method, of between $3.5 \text{ m}^2/\text{g}$ and $6.0 \text{ m}^2/\text{g}$. *See* Shiobara, col. 6, lines 15-28; col. 7, lines 1-9. In addition, the Shiobara compositions may include auxiliary silica fillers having a specific surface area of $50 \text{ m}^2/\text{g}$ to $300 \text{ m}^2/\text{g}$. *See* Shiobara, col. 7, lines 29-36.

Based on these disclosures, the Office Action takes the position that the pending claims are anticipated by or obvious over Shiobara. Applicants respectfully disagree.

In contrast to Shiobara, claim 1 requires that the inorganic particles of its adhesive composition have a specific surface area of from $11 \text{ m}^2/\text{g}$ to $17 \text{ m}^2/\text{g}$. Shiobara does not disclose, nor does it suggest, the use of inorganic particles having specific surface areas within this range. Rather, Shiobara teaches inorganic filler materials having smaller specific surface areas, from $3.5 \text{ m}^2/\text{g}$ to $6.0 \text{ m}^2/\text{g}$, or auxiliary silica filler materials having much larger specific surface areas, from $50 \text{ m}^2/\text{g}$ to $300 \text{ m}^2/\text{g}$. *See* Shiobara, col. 7, lines 1-9; col. 7, lines 29-36. Thus, Shiobara does not disclose, nor does it suggest, the inorganic particles of claim 1, and therefore does not disclose or suggest the adhesive compositions of claim 1 or its dependent claims.

For at least these reasons, Applicants respectfully submit that claims 1 and 4-6 are patentable over Shiobara. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 4-6 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Terminal Disclaimer

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